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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,374	07/14/2005	Hiroki Akatsuka	Q87773	7777
23373	7590	05/09/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	
			MAIL DATE	DELIVERY MODE
			05/09/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/542,374

**Applicant(s)**

AKATSUKA ET AL.

**Examiner**

Thanh K. Truong

**Art Unit**

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to applicant's amendment received on February 26, 2007.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Koike (US 2002/0189970).

Koike discloses an apparatus comprising: a shock absorbing material (10, 20, 30) for packaging, the material comprising a hole for deaeration (figures 1 and 2 show holes are formed on all sides of the shock absorbing material) which is formed so as to penetrate between a first surface (such as the bottom surface or the outside surfaces of the shock absorbing material) thereof which is brought into contact with an inner surface of a packaging carton (2) when the shock absorbing material is placed in the packaging carton (figure 1), and a second surface (such as the top surface or the inside surfaces of the shock absorbing material) thereof on which a target to be packed (50) is placed via a thin film member (6) for packaging which is thinly formed.

Koike further discloses:

Regarding claim 2, the shock absorbing material has a deaerating-duct insertion opening which is formed so as to penetrate between the first and second surfaces, and

Art Unit: 3721

into which a deaering duct can be inserted (it is construed that the shock absorbing material has grooves and recesses that openings are formed so as to penetrate between the first and second surfaces, and a deaering duct is certainly capable of being inserted into these openings all around the shock absorbing material. Furthermore, the functional recitations of claim 2 only require that the apparatus is capable of performing the functioning as recited).

Regarding claim 3, the material includes grooves for deaeration which are formed in either or both of the first and second surfaces, and which provide communication between the deaering-duct insertion opening and the hole for deaeration (see paragraph regarding claim 2 above).

Regarding claim 4, the hole for deaeration is formed on a side of a dented portion for product placement formed in the second surface (as mentioned above, holes are formed all around the shock absorbing material for deaeration, and figures 4, 6 and 8 show that the product (50) is placed in the dented portion in the second surface).

Regarding claim 7, at least one dented portion in the second surface, the dented portion for placement of the product therein, wherein at least two holes for deaeration are formed in the dented portion (see paragraph regarding claim 2 above).

### ***Response to Arguments***

4. Applicant's arguments filed February 26, 2007 have been fully considered but they are not persuasive.

Art Unit: 3721

5. In response to the Applicant's argument that: "There are no actual "holes" formed in the shock absorbing material 10, 20, 30 of Koite", the examiner disagrees for the following reason:

The American Heritage Dictionary, defines a "hole" as follow:

1. A hollowed place in something solid; a cavity or pit.
2. An opening or perforation.
3. A space in an otherwise solid mass
4. An opening, especially in a solid structure
5. An open space allowing passage

(The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2004, 2000 by Houghton Mifflin Company.)

Accordingly, the examiner maintains that figures 1-8 of Koike clearly show that holes are formed on all sides of the shock absorbing material. For example, figure 1 shows opening spaces between projections, on all sides, of each of shock absorbing materials (10, 20, 30), figure 2A and 2B show the hollowed places between projections (25, 35) on all sides of each of shock absorbing materials (20, 30). Moreover, figures 4, 6 and 8 show that when the shock absorbing materials (10, 20 30) are stacking with the article (50) in between them, holes are formed between the article being packed and the shock absorbing materials.

Furthermore, as mentioned above in paragraph 3 of this office action, in an apparatus claim, the functional recitation in the claim does not constitute a structure limitation of the claim, and thus the examiner maintains that the functional recitations in

Art Unit: 3721

a claim only require that the apparatus is capable of performing the functioning as recited.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

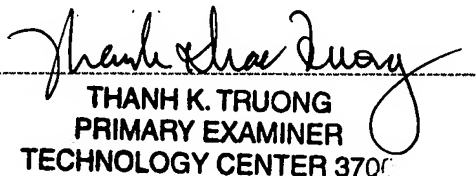
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

tkf  
May 4, 2007.

  
THANH K. TRUONG  
PRIMARY EXAMINER  
TECHNOLOGY CENTER 3700